

### **REMARKS/ARGUMENTS**

Upon entry of the foregoing amendment, claims 1-18 are pending in the application, with claims 1, 2 and 6 being the independent claims. Claims 1, 2, 4 and 6 have been amended. Reconsideration of this Application and entry of this Amendment is respectfully requested.

#### **Confirmation of Species and Sub-species Election**

Applicants confirm the provisional election of species made on October 9, 2006, at which time Applicants elected to prosecute Species A (FIG. 1) along with subspecies DD (FIG. 3c). Claims 1-18 are readable on the elected species and subspecies.

#### **Objection to the Specification**

The Examiner objected to the specification as failing to provide antecedent basis for the claimed subject matter. Particularly, the Examiner states that there does not appear to be support for the two part reinforcing member having a reduced stiffness from a proximal end to a distal end, as claimed in claim 4. Applicants' specification supports this feature of claim 4. With reference to the embodiment shown in FIG. 9 and described on page 20 in paragraph [0083], proximal shaft 902 is described as having any of the cross-sections shown in FIGS. 2-4, which includes FIG. 3c. The description that follows in paragraph [0083] is directed to reducing the size or shape of the reinforcing means as it extends distally to reduce the stiffness. Accordingly, at least this disclosure in Applicants' specification supports the subject matter of claim 4.

#### **35 U.S.C. §112 Rejection**

The Examiner rejected claim 1 under 35 U.S.C. §112, paragraph 2, as being indefinite for failing to particularly point out and distinctly claim the subject matter applicant regards as the invention. Particularly, the Examiner questions support for the "guide member" feature of the claim. On page 4 in paragraph [0016] and on page 5 in paragraph [0017], a guide member for use on an MX catheter shaft is described. On page 4 in paragraph [0015] reference is made to MX catheters disclosed in various patents and patent publications that are incorporated by reference. The guide member of claim 1 is supported by this disclosure. However, Applicants

have decided to amend claim 1 to remove the guide member limitation as it is not needed for patentability of the claim.

35 U.S.C. §102(e) Rejections

Claims 2-5 are rejected under 35 U.S.C. §102(e) as being anticipated by U.S. Patent Publ. No. 2003/0105427 to Lee et al. Lee et al. discloses various rapid exchange catheter embodiments. Essentially, the Examiner bases her rejection on a rapid exchange junction (see references numbers 25, 31 in FIG. 1/FIG. 8) between the proximal and distal shaft members (see reference numbers 22, 26, 27) of one of the rapid exchange catheter embodiments disclosed in Lee et al. The Examiner indicates that a dual lumen proximal shaft is disclosed in the rapid exchange junction cross-section shown in FIG. 10 and refers to a distal end of the proximal shaft member 22 within the junction as a two part reinforcing member.

Applicants have amended independent claim 2 to clarify the subject matter is directed to a catheter having a full-length guidewire lumen with a dual lumen proximal shaft having, inter alia, a first and second reinforcing member in an annular inflation lumen thereof. Such a catheter shaft is not disclosed by any of the embodiments of rapid exchange catheters of Lee et al., as proximal member 22 of Lee et al. is a single lumen polymeric or hypotube tubular member having only an inflation lumen 20. Lee et al., paragraphs [0027] and [0034]. Accordingly, independent claim 2 is not anticipated by and is patentable over the Lee et al. publication.

Claims 3-5 depend from and add further features to independent claim 2 and are patentable for that reason alone. While it is not necessary to address the Examiner's rejection of the dependent claims at this time, Applicants reserve the right to support their patentability, when necessary.

Allowable Subject Matter

The Examiner indicated claim 1 would be allowable if rewritten to overcome the rejection under 35 U.S.C. § 112, paragraph 2. As mentioned above, Applicants have addressed the Examiner's rejection of claim 1 and believe it is now in condition for allowance.

The Examiner objected to claims 6-18 as being dependent on a rejected base claim but allowable if rewritten in independent form. Claim 6 has been amended to be in independent form to include all the limitations of the rejected base claim, i.e., claim 2. Accordingly claim 6 is

now in condition for allowance. Claims 7-18 depend, directly or indirectly, from claim 6 and therefore are also in condition for allowance.

Conclusion

For the foregoing reasons, Applicant believes all the pending claims are in condition for allowance and should be passed to issue. The Commissioner is hereby authorized to charge any additional fees which may be required under 37 C.F.R. 1.17, or credit any overpayment, to Deposit Account No. 01-2525. If the Examiner feels that a telephone conference would in any way expedite the prosecution of the application, please do not hesitate to call the undersigned at telephone (707) 543-0221.

Respectfully submitted,

/Catherine C. Maresh, Reg. No. 35,268/  
Catherine C. Maresh  
Registration No. 35,268  
Attorney for Applicant

Medtronic Vascular, Inc.  
3576 Unocal Place  
Santa Rosa, CA 95403  
Facsimile No.: (707) 543-5420